

## **REMARKS**

The Specification has been amended. Claim 12 has been amended. No new matter has been introduced with these amendments, all of which are supported in the application as originally filed. Claims 1 - 2 and 4 - 12 remain in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment/Response is not patentable over the art cited by the Examiner, and claim amendments and cancellations made in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as previously presented and additional claims, in one or more continuing applications.

### **I. Response to Arguments**

Paragraph 2 of the Office Action dated November 2, 2007 (hereinafter, “the Office Action”) discusses Claim 3, stating “... claim 3 limitations has been met Shaffer [sic]”. Applicants respectfully note that Claim 3 was cancelled from the application in their response dated August 13, 2007.

### **II. Rejection under 35 U. S. C. §112(b)**

Paragraph 3 of the Office states that Claim 11 is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap

between the elements. This rejection is respectfully traversed.

The Office Action states “The omitted elements are: to determine current values ...” (emphasis original). This is not an omission of essential elements. The phrase “a current value” is recited at lines 5 - 6 of independent Claim 10, and the phrase “determine the current value” is recited at line 7 of independent Claim 10 (and “instructions configured to” is recited at line 3 of Claim 10). The phrase “the instructions configured to determine” on lines 1 - 2 of Claim 11 refers to this “instructions configured to ... determine the current value ...” from lines 3 and 7 of Claim 10, from which Claim 11 depends.

Accordingly, antecedent basis has been properly established, and “current value” has not been “omitted” from the claim language nor does the language of Claim 11 have any “gap between the elements”. The Examiner is therefore respectfully requested to withdraw the §112 rejection.

### III. Rejection under 35 U. S. C. §102(b)

Paragraph 4 of the Office Action states that Claims 1 - 5 are rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent 6,345,279 to Shaffer et al. (hereinafter, “Shaffer”). Applicants presume this reference should be to U. S. Patent 6,842,768 B1 to Shaffer, as U. S. Patent 6,345,279 was issued to Li. Applicants also note that Claim 3 has previously been cancelled from the application, and that Claim 12 is addressed within para. 4 of the Office Action but omitted from this caption. This rejection is respectfully traversed with regard to Claims 1 - 2,

4 - 5, and 12.

As stated by the Court of Appeals for the Federal Circuit, “Anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” *Apple Computer Inc. v. Articulate Sys. Inc.*, 57 U.S.P.Q.2d 1057, 1061 (Fed. Cir. 2000), emphasis added. In another case, the Court of Appeals stated that a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). In yet another case, the Court of Appeals held that a finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002).

Referring first to independent Claim 1, this claim recites:

A method of providing autonomic content load balancing, comprising:  
defining a plurality of alternative versions of a Web page to be served,  
along with values of one or more conditions under which each of the alternative  
versions should be selected;  
receiving a request for the Web page ;  
determining current values of the conditions;  
using the determined current values to select one of the alternative  
versions; and  
serving the selected version of the Web page, responsive to the request.  
(emphasis added)

Applicants respectfully submit that Shaffer fails to teach, or suggest, at least the above-underlined recitations of Claim 1, as will now be discussed.

With reference to the claim language on lines 3 - 4 of Claim 1 (“defining ...”), the Office Action cites Shaffer’s **Fig. 6** and states “clickable underlined links corresponding to files available for download with different compression formats and download time” (Office Action, p. 4, lines 1 - 3). Applicants respectfully disagree with this analysis. The “clickable underlined links” do, in fact, correspond to files that are “available for download”. However, none of these clickable underlined links is an “alternative version[ ] of a Web page”, in contrast to line 3 of Applicants’ Claim 1. Instead, Shaffer shows:

- a “Wave File” corresponding to an “Outside Phone Call” in the first row of table **400** in **Fig. 6**;
- a “Transcribed Text” file corresponding to a phone call to “Ext. [extension] 613” in the second row;
- an “Audio Attachment” to that phone call in the third row;
- 2 email files (as denoted by the “envelope” shape at the left margin) in the fourth and fifth rows;
- a “PDF” file attachment, as noted in the sixth and seventh rows;
- a “Transcribed Text” file corresponding to a phone call to “Ext. [extension] 381” in the eighth row;
- an “Audio Attachment” to that phone call in the ninth row;
- another email file in the tenth row; and
- another “Wave File” corresponding to an “Outside Phone Call” in the eleventh row of table **400** in **Fig. 6**.

Clearly, “wave” files, text transcribed from phone calls, audio attachment files, email files, and PDF files are not alternative versions of a Web page. Accordingly, this table **400** in **Fig. 6** cannot be used as teaching the “defining a plurality of alternative versions of a Web page ...” claim element recited in lines 3 - 4 of Applicants’ Claim 1.

Accordingly, differences exist between Shaffer and Applicants’ claimed invention as recited in Claim 1, and thus Shaffer does not anticipate Claim 1 according to the holding in *Scripps Clinic*. Applicants also respectfully submit that the above-provided discussions demonstrate that Shaffer fails to disclose each and every limitation of independent Claim 1, in that there is no disclosure of “defining a plurality of alternative versions of a Web page ...” (Claim 1, lines 3 - 4, emphasis added), and thus Shaffer does not anticipate Claim 1 according to the holding in *Apple Computer Inc.*

Stated another way, it can be seen that absolute identity is not found in Shaffer’s disclosure for each and every element of Claim 1, and thus Shaffer does not anticipate Claim 1 according to the holding in *Trintec Indus.*

Applicants therefore respectfully submit that independent Claim 1 is patentable over Shaffer. Dependent Claims 2, 5, and 8 depend from Claim 1, and these dependent claims are therefore considered patentable by virtue of (*inter alia*) the patentability of Claim 1.

Furthermore, Applicants respectfully note that dependent Claim 2 recites “... each of the

alternative versions comprises the Web page represented using a different media type” (emphasis added). The Office Action cites col. 6, lines 23 - 49; col. 9, lines 11 - 41; and **Fig. 6** as teaching the limitations of Claim 2 (Office Action, p. 4, lines 15 - 18). However, Applicants respectfully submit that mention of a “multimedia message system” (col. 6, lines 24 - 25), or “some messages can themselves be digitally encoded audio data or video data” (col. 6, lines 46 - 47), or “for some messages, the invention lists a download time as an uncompressed file ... or as a compressed file ... in one or two alternative formats” (col. 9, lines 14 - 17) does not teach, or suggest, a Web page that is represented using different media types. Accordingly, the cited portions of Shaffer do not teach the limitations of Claim 2, and Claim 2 is deemed patentable over Shaffer for these reasons as well.

With regard to dependent Claim 4, Applicants respectfully note that Claim 4 is not dependent on Claim 1, but instead is dependent on independent Claim 6. Claim 6 was rejected under 35 U. S. C. §103(a) (see Office Action, para. 5.) Accordingly, its dependent Claim 4 cannot be rejected under 35 U. S. C. §102.

Referring next to independent Claim 12, this claim as currently presented recites:

A computer program product for using dynamically selectable content versions, the computer program product embodied on one or more computer-readable storage media and comprising:

computer-readable program code for identifying at least one condition associated with content having a plurality of selectable versions, wherein the content forms a portion of a particular Web page;

computer-readable program code for determining a current value of each of the at least one identified conditions;

computer-readable program code for using the determined current value for each of the at least one identified conditions to select from among the

selectable versions of the content; and  
computer-readable program code for storing the selected version as the  
content for the portion of the particular Web page. (emphasis added).

Applicants note that the Office Action uses the same analysis for rejecting independent Claim 12 as for rejecting independent Claim 1 (see Office Action, para. 4, line 3), even though the claim elements are different between these two claims. As discussed above with reference to Claim 1, the cited text from Shaffer does not teach, or suggest, alternative versions that pertain to a Web page. Furthermore, with regard to the claim elements of Claim 12, Applicants respectfully submit that Shaffer does not teach, or suggest, “... content having a plurality of selectable versions, wherein the content forms a portion of a particular Web page” (Claim 12, lines 4 - 6, emphasis added) or “... storing the selected version as the content for the portion of the particular Web page” (Claim 12, lines 11 - 12, emphasis added).

Accordingly, differences exist between Shaffer and Applicants’ claimed invention as recited in Claim 12, and thus Shaffer does not anticipate Claim 12 according to the holding in *Scripps Clinic*. Applicants also respectfully submit that the above-provided discussions demonstrate that Shaffer fails to disclose each and every limitation of independent Claim 12, in that there is no disclosure of the above-quoted recitations from lines 4 - 6 or lines 11 - 12 of Claim 12, and thus Shaffer does not anticipate Claim 12 according to the holding in *Apple Computer Inc.*

Stated another way, it can be seen that absolute identity is not found in Shaffer’s disclosure for each and every element of Claim 12, and thus Shaffer does not anticipate Claim 12

according to the holding in *Trintec Indus.*

Applicants therefore respectfully submit that independent Claim 12 is patentable over Shaffer.

In view of the above, the Examiner is respectfully requested to withdraw the §102 rejection.

IV. Rejection under 35 U. S. C. §103(a)

Paragraph 5 of the Office Action states that Claims 6 - 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shaffer in view of U. S. Patent 5,649,200 to Leblang et al. (hereinafter, “Leblang”). This rejection is respectfully traversed.

Section 2143.03 of the MPEP, “All Claim Limitations Must Be Considered” (which is found within Section MPEP §2143, titled “Examples of Basic Requirements of a *Prima Facie* Case of Obviousness”), quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added)

Referring first to independent Claim 6, this claim as currently presented recites:

A method of using dynamically selectable content versions, comprising:  
receiving a request for content having selectable versions;  
identifying at least one condition associated with the selectable versions;  
determining a current value for each of the at least one identified



conditions;  
determining a directory structure location associated with the content;  
using the determined current value for each of the at least one identified conditions to select a path within the directory structure location; and  
using the selectable version of the content which is stored at the selected path to create a response to the request. (emphasis added).

Applicants find no teaching or suggestion in Shaffer or Leblang of at least the above-underlined recitations of Claim 6, as will now be discussed.

For the “using the determined current value for each of the at least one identified conditions to select a path ...” claim element recited on lines 7 - 8 of Claim 6 (emphasis added), the Office Action quotes the “using the determined current value for each of the at least one identified conditions to select” portion of this claim language at p. 6, lines 4 - 5 of the Office Action, but provides no citation. Furthermore, the Office Action impermissibly changes the meaning of this phrase, replacing “select a path” with “select (a content version)”. Claim 6 does not recite “select a content version”, and thus the analysis of Claim 6 has failed to consider all the words of the claim, in violation of the above-quoted holding from *In re Wilson*.

On p. 7, lines 7 - 8, the Office Action cites col. 27, lines 4 - 31 and the Abstract of Leblang as teaching “select a path within the directory structure location”, which is a portion of the claim element recited on lines 7 - 8 of Claim 6. On lines 3 - 6 of the Leblang Abstract, Applicants find a discussion of using “a set of selection rules” with “an object version selector”, for “providing the processor with access only to specific versions of target data objects”. However, this in no way teaches or suggests “using the determined current value ... to select a

path ...” as recited by Applicants on lines 7 - 8 of Claim 6. Applicants are unable to determine which portion of the cited text in col. 27, lines 4 - 31 is relied on in the Office Action as supposedly teaching this claim language. Applicants note that lines 4 - 5 of col. 27 state “**FIG. 18** shows that more than one name can be associated with the same element.”; however, Applicants respectfully submit that this is different from their claim language, which recites “using the determined current value ... to select a path ...” (Claim 6, lines 7 - 8).

Applicants also respectfully note that Leblang defines “version” at col. 26, lines 62 - 65, stating:

A version of a directory element of this invention is a list of names, each of which has a pointer to another object in the same VOB [versioned object base], a file element, a directory element, or a VOB symbolic link.

Applicants fail to see any relevance of such “version” to their claimed invention.

Referring next to the claim element on lines 9 - 10 of Claim 6, which recites “using the selectable version of the content which is stored at the selected path [that was selected “using the determined current value”; see antecedent on lines 7 - 8] to create a response to the request”, the Office Action cites col. 2, lines 6 - 21 and col. 28, line 23 - 49 of Leblang (Office Action, p. 7, lines 9 - 12). Applicants also respectfully note that a number of additional words are provided therein, in particular “using the determined current values to select from among the selectable versions”; however, these words are not part of this claim element.

With reference to the cited text from col. 2, lines 6 - 21, Applicants are unable to

determine which portion of this cited text is relied on in the Office Action as supposedly teaching the claim language from lines 9 - 10 of Claim 6. Applicants note that col. 2, lines 8 - 9 discuss “views”, stating that “each [view] selects a particular configuration of source versions”.

Applicants’ claim language does not recite “views”, or that such views are used to select “a particular configuration of source versions”. Lines 16 - 17 of col. 2 state “Each versioned object appears to be an ordinary file or directory.”. Applicants also respectfully submit that this fails to teach, or suggest, “using the selectable version of the content which is stored at the selected path [that was selected using the determined current value]” (Claim 6, lines 9 - 10, emphasis added).

With reference to the cited text from col. 28, lines 23 - 49, Applicants are unable to determine the relevance of this cited text to the claim language from lines 9 - 10 of Claim 6.

Applicants note that col. 28, lines 29 - 32 state

The name mechanisms used to access file elements apply to accessing directory elements as well. For example, version-extended naming provides direct access to the different versions of the directory. Different views can select different versions of a directory.

As noted earlier, Applicants’ claim language does not recite “views”, or using views to “select different versions of a directory”. Furthermore, Applicants’ claim language does not recite “version-extended naming”, or use of such names to provide “direct access to the different versions of the directory”. Instead, Applicants’ claim language recites “using the determined current value ... to select a path ...” and then “using the selectable version ... which is stored at the selected path ...” (Claim 6, lines 7 - 10).

In view of the above, Applicants respectfully submit that the Office Action analysis has not properly considered all of the words of independent Claim 6, and that the cited references fail to teach or suggest all of the limitations recited in Claim 6. Claim 6 is therefore deemed patentable over Shaffer, Leblang, or a combination thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art would be motivated to attempt it). Dependent Claims 4, 7, and 9 depend from Claim 6, and these dependent claims are therefore considered patentable by virtue of (*inter alia*) the patentability of Claim 6.

In the analysis on p. 6, lines 6 - 9, the Office Action presents claim language apparently taken from dependent Claim 8 within the analysis of independent Claim 6. Claim 8 does not depend from Claim 6, as noted earlier, and Applicants therefore respectfully submit that the limitations of Claim 8 have not been properly considered, in violation of the above-quoted holding from *In re Wilson*. Furthermore, dependent Claim 8 is deemed patentable by virtue of the patentability of independent Claim 1 from which it depends.

Referring next to independent Claim 10, this claim as currently presented recites:

A computer-implemented system for providing autonomic content load balancing, comprising a processor and a memory coupled thereto, the memory storing instructions configured to:

receive a request for content, the content comprising at least two different portions, each of which has associated therewith a plurality of alternative versions and at least one condition, a current value of each condition being usable for selecting from among the alternative versions;

determine the current value of each of the at least one conditions associated with each of the different portions;

use the determined current values to select one of the alternative versions for each of the different portions; and

serve the content using the selected version for each of the different

portions, responsive to the request. (emphasis added).

Page 7, lines 13 - 17 of the Office Action state “As to claim 10, this is a computer-implemented system with similar limitations as in claims 6-8 above.”. Applicants respectfully disagree. For example, whereas Claim 6 recites “determining a directory structure location ...” on line 6 and “... select a path within the directory structure location” on line 8, Claim 10 does not mention “directory structure”. Furthermore, Claim 10 recites “... the content comprising at least two different portions, each of which has associated therewith a plurality of alternative versions ...” (Claim 10, lines 4 - 5, emphasis added), which recitations are not found in Claim 6. Accordingly, Applicants respectfully submit that the Office Action analysis has not considered all of the words of independent Claim 10, in violation of the above-quoted holding from *In re Wilson*.

Applicants therefore respectfully submit that independent Claim 10 is patentable over Shaffer, Leblang, or a combination thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art would be motivated to attempt it). Dependent Claim 11 depends from Claim 10, and this dependent claim is therefore considered patentable by virtue of (*inter alia*) the patentability of Claim 10.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejection.

## V. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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